

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DENIS FERNAND BRODEUR, IDA SEEN LEUNG, and
FLANNAN LOK-HANG LO

Appeal 2012-011945
Application 12/622,709¹
Technology Center 2100

Before ST. JOHN COURTENAY III, THU A. DANG, and
LARRY J. HUME, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–24, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ According to Appellants, the real party in interest is International Business Machines Corporation. App. Br. 2.

Invention

The claimed invention on appeal “relates to Service Component Architecture (SCA), and more particularly to apparatus and methods for analyzing and resolving SCA runtime errors in process servers, such as WebSphere Process Server.” (Spec. ¶ 1).

Representative Claim

Independent claim 1 is representative of the rejected claims on appeal:

1. A method for analyzing and resolving problems in a process server, the method comprising:

[a] receiving a log file associated with an application running on the process server, the application comprising higher-level service component artifacts, and lower-level implementation artifacts used to implement the service component artifacts;

[b] identifying error messages in the log file;

[c] determining what implementation artifacts are associated with the error messages;

[d] *mapping the implementation artifacts to service component artifacts that are associated with the implementation artifacts*; and

[e] *displaying the error messages and their relationship to the service component artifacts*.

(Contested limitations emphasized, lettering added for each step [a], [b], [c], [d], and [e].)

Rejections

- A. The Examiner rejected claims 19–24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
- B. The Examiner rejected claims 1, 3–10, and 12–24 under 35 U.S.C. § 102(e) as anticipated by Chan (US 2009/0064174 A1 published Mar. 5, 2009).
- C. The Examiner rejected claims 2 and 11 under 35 U.S.C. § 103(a) as obvious over Chan and the website: www.ibm.com.

ANALYSIS

Rejection A under § 101 of claims 19–24

Regarding rejection A, Appellants cite relevant case law but advance no substantive arguments in the principal Brief. (App. Br. 8, *see also* Examiner’s response, Ans. 12: “In regard to the USC 101 rejection, there doesn’t appear to be any substantial arguments to respond to. The Applicant’s response merely cites case law and does not address the subject matter in the claims specifically”). Arguments not raised are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv)(2012).

We further observe Appellants’ Specification (¶ 24) describes computer- readable media in terms of non-limiting exemplary embodiments: “[0024] Any combination of one or more computer-usable or computer-readable medium(s) may be utilized. The computer-usable or computer-readable medium *may be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, or device.*” (Emphasis added).

To the extent our new PTAB procedural rules may permissively allow new arguments regarding dictionary definitions to be introduced at any stage

in the appeal process, we fully consider Appellants' additional substantive argument advanced for the first time in the Reply Brief:² *See* note 1 *supra*.

Claim 19 was amended on September 16, 2011 from “computer readable medium” to “computer readable device.” The word device is defined as: “a piece of equipment or a mechanism designed to serve a special purpose or perform a special function” (Meriam-Webster On-line Dictionary). A device precludes non-transitory embodiments in the specification, and is necessarily non-transitory.

(Reply Br. 6).

In considering the argued extrinsic dictionary definition for “device,” as applied to the claimed “computer-readable storage device having computer-readable program embodied therein” (claim 19), we find PTAB precedential opinion *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) is controlling. Under *Mewherter*, the scope of a “computer readable storage medium” (i.e., storage device) was held to encompass transitory media such as signals or carrier waves, where, as here, the Specification does not expressly disclaim transitory forms. (Spec. ¶ 24). The recited “computer-readable storage device” of claims 19–24 is not claimed as non-transitory, and the Specification does not expressly and unambiguously disclaim transitory forms such as propagating signals via a definition or

² *See* 37 C.F.R. § 41.30: “Definitions. In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart unless otherwise clear from the context: . . . Evidence means something (including testimony, documents and tangible objects) that tends to prove or disprove the existence of an alleged fact, *except that for the purpose of this subpart Evidence does not include dictionaries, which may be cited before the Board.*” (Emphasis added).

disclaimer.³ We note the holding of *Mewherter* is binding on all members of the Board under agency authority (SOP2). Therefore, we conclude the scope of the claimed “computer-readable storage device” of claims 19–24 encompasses transitory forms and is ineligible under § 101. Accordingly, we sustain the Examiner’s § 101 rejection of claims 19–24 as being directed to non-statutory subject matter.

Rejection B under §102

Regarding the anticipation rejection of claim 1, Appellants substantively contest limitations [d] and [e]. Regarding limitation [d], Appellants contend, *inter alia*:

Chan is mapping message data to a message, not mapping an implementation artifact to a service component artifact. This is more clearly spelled out in paragraph [0018] “the message entry map is utilized to configure mapping engine **115** to map information from the identified message entry fields comprised within a message to an audit record message”.

Moreover, Chan clearly states in paragraphs [0016] and [0019] that it uses a single mapping artifact and engine. Thus, it cannot map a lower level implementation to a higher-level service component artifact.

(App. Br. 9).

In reviewing the statement of rejection, Appellants’ arguments in the Briefs, and the Examiner’s responsive arguments (Ans. 10–12), we find the

³ We refer Appellants to the February 23, 2010 “Subject Matter Eligibility of Computer Readable Media ” policy statement by former PTO Director David J. Kappos, as published in the Official Gazette of the United States Patent and Trademark Office (USPTO), 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010), *available at* <http://www.uspto.gov/web/offices/com/sol/og/2010/week08/TOC.htm#ref20>

Examiner paints with a broad brush in making the anticipation rejection. On this record, we are left to speculate regarding: (1) the details of how the Examiner has construed the claimed “implementation artifacts” and “service component artifacts” under a broad but reasonable interpretation, and (2) the mapping of each of these contested claim terms to *specific* corresponding *data elements* in the Chan reference.⁴

At best, we find the Examiner has only clearly mapped the claimed “error messages” of claim 1 (limitation [b]) to “an audit record message such as [the] Comment Base Event message” described in paragraph 17 of Chan. (Ans. 7). We decline to make speculative assumptions regarding the Examiner’s intended mapping regarding the features of the contested claim terms “implementation artifacts” and “service component artifacts” as recited in limitations [a], [c], [d], and [e].

Although the Examiner paraphrases and quotes paragraphs 17, 18, and 19 of Chan in the response to arguments (Ans. 10–12), we find the Examiner’s specific mapping of each contested claim term to the corresponding feature in Chan is unclear, such that no *prima facie* case of anticipation has been established. We note that the Board is a reviewing body and not a place of initial examination. The rigorous requirements of

⁴ A finding that a claim is anticipated under 35 U.S.C. § 102 involves two analytical steps: First, the PTO must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, a court’s review of the Board’s claim construction is limited to determining whether it was reasonable. *In re Morris*, 127 F.3d 1048, 1055 (Fed.Cir.1997). Secondly, the Board must compare the construed claim to a prior art reference and make factual findings that “each and every limitation is found either expressly or inherently in [that] single prior art reference.” *In re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

anticipation require a clear mapping of each claim limitation to the corresponding feature found in the reference, which the Examiner must identify with particularity. The prima facie burden has not been met and the rejection does not adhere to the minimal requirements of 35 U.S.C. § 132 “when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

Because the Examiner has not construed and mapped the contested “implementation artifacts” and “service component artifacts” to the Chan reference with particularity, the Examiner has not shown that Chan anticipates at least contested limitations [d] and [e], as recited in commensurate form in each independent claim on appeal. Independent claims 10 and 19 each recite the contested claim terms “implementation artifacts” and “service component artifacts” similar to claim 1. Therefore, for these reasons, we reverse the Examiner’s anticipation rejection B of independent claims 1, 10, and 19, and we also reverse anticipation rejection B of each associated dependent claim.

Rejection C under §103

Regarding rejection C under § 103, the Examiner has not identified how the cited website evidence (www.ibm.com) remedies the above noted deficiencies regarding Chan. Further, we are unable to locate a copy of screenshots of the cited website (www.ibm.com) in the official eDan USPTO electronic file, as required for the Board to consider the *date* and *relevance* of this purported evidence. Nor is this website cited on the single PTO-892 form of record (Notice of References Cited, June 17, 2011).

In reviewing the record, we particularly note the following
“Miscellaneous Communication to Applicant” (mailed July 6, 2012), which
fails to provide screenshots of the website:

This communication is to correct section 8 of the Examiner’s
Answer under reference. The Examiner did not mention the
reference www.ibm.com under Websphere process server. This
is an official notice that this reference should be included under
section 8 of the Examiner’s Answer.

(Miscellaneous Communication mailed July 6, 2012, page 2).

“As the statute itself instructs, the examiner must ‘notify the
applicant,’ ‘stating the reasons for such rejection,’ ‘together with such
information and references as may be useful in judging the propriety of
continuing prosecution of his application.’ 35 U.S.C. § 132.” *In re Jung*,
637 F.3d 1356, 1363 (Fed. Cir. 2011). On this record, we find the Examiner
has not met the requisite burden under 35 U.S.C. § 132. Without more
information, we decline to consider an undated web site address as evidence
(www.ibm.com). Accordingly, we reverse the Examiner’s rejection C of
claims 2 and 11 under § 103.

CONCLUSIONS ⁵

The Examiner did not err in rejecting claims 19–24 under § 101.

The Examiner erred in rejecting claims 1, 3–10, and 12–24 under § 102.

The Examiner erred in rejecting claims 2 and 11 under § 103.

⁵ We observe the steps or acts of method claim 1 appear to be capable of being performed as mental steps by a person, with the aid of pen and paper. *See Cybersource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011). In the event of further prosecution of this application, and to the extent Appellants’ claims are directed to an abstract idea, we leave it to the Examiner to review all the claims for compliance under 35 U.S.C. § 101 in light of the recently issued 2014 Interim Guidance on Patent Subject Matter Eligibility (<https://www.federalregister.gov/articles/2014/12/16/2014-29414/2014-interim-guidance-on-patent-subject-matter-eligibility>) and the preliminary examination instructions on patent eligible subject matter. *See* “Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*,” Memorandum to the Examining Corps, June 25, 2014. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) 1213.02.

DECISION

We affirm the Examiner's decision rejecting claims 19–24 under § 101.

We reverse the Examiner's decision rejecting claims 1, 3–10, and 12–24 under § 102.

We reverse the Examiner's decision rejecting claims 2 and 11 under § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART

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